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JENNIFER S. SICKLER
1000 LOUISIANA
SUITE 3400
HOUSTON TX 77002

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JUN 24 2004

OFFICE OF PETITIONS

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|---------------------------------|---|--------------------------|
| In re Application of | : | |
| Smitherman et al. | : | |
| Application No. 10/664,737 | : | DECISION REFUSING STATUS |
| Filed: September 18, 2003 | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No. 127976-1000 | : | |

This is in response to the petition under 37 CFR 1.47(a), filed April 28, 2004. Applicants obtained a one-month extension of time to reply. Accordingly, the petition is filed timely.

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on September 18, 2003, with a declaration without all of the inventors' signatures. Accordingly, on January 29, 2004, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring the signatures of Tuy Vu Mai and Leo Peters III and a surcharge for the late filing of the declaration. Additionally, the Notice to File Missing Parts indicated that a new oath or declaration was required, which identified the residence of each inventor.

On January 29, 2004, the Office also mailed a Notice of Incomplete Reply, stating that the reply on October 20, 2003, to the Notice to File Missing Parts had been entered. However, the reply did not include the signature of Leo Peters III. Again, the Office indicated that a new oath or declaration was required, which identified the residence of each inventor.

In response, on April 28, 2004, applicants filed the present petition, a declaration signed by two of the three joint inventors, a request for a one-month extension of time to reply, and paid the necessary fees.

In the Declaration of Facts, R. Bradford Perry states that the assignee, through its attorney, sent Leo J. Peters III a letter dated September 26, 2003, enclosing a Declaration for execution. A copy of the letter accompanies the petition. The letter indicates: "Enclosed for your review and execution is a Declaration and Power of Attorney for the nonprovisional patent application." *Letter of Jennifer S. Sickler, dated September 26, 2003.* Mr. Perry further states that Mr. Peters indicated that he was not willing to sign declaration, and has failed to do so.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lack items (1) and (2) as set forth above.

As to item (1), it appears that Mr. Peters was presented with only a copy of the Declaration and Power of Attorney. Unless Mr. Peters was presented with a complete copy of the application papers, including the specification, claims and drawings, he could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration that he was given. Accordingly, applicants failed to show or provide proof that the nonsigning inventor has refused to sign the declaration. See MPEP 409.03(d). To show that the inventor has refused to join in the application, applicants must show that complete copies of the application papers, including the specification, claims and drawings, were presented to Mr. Peters, personally or through his designated representative, and that he did not respond to the request that he sign the declaration.

As to item (2), applicants failed to submit an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64. The declaration does not identify the residence or mailing address of Mr. Peters. The Office notes that the oath or declaration must identify "[t]he mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor. . . ." 37 CFR 1.63(c)(1). Accordingly, to correct the deficiencies, applicants must submit an oath or declaration in compliance with 37 CFR 1.63 and 1.67, which identifies the entire inventive entity, the correct mailing address and citizenship of each inventor, and is signed by the two signing inventors on behalf of Mr. Peters, the nonsigning inventor.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Christina Tartera Donnell, Senior Petitions Attorney:**

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions